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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,206	01/21/2004	Dennis A. Schober	SCHO-1-1004	2510
25315	7590	06/30/2005	EXAMINER	
BLACK LOWE & GRAHAM, PLLC 701 FIFTH AVENUE SUITE 4800 SEATTLE, WA 98104			XU, LING X	
			ART UNIT	PAPER NUMBER
			1775	

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/762,206	Applicant(s) SCHOBER, DENNIS A.	
	Examiner Ling X. Xu	Art Unit 1775	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 May 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 and 40-91 is/are pending in the application.
- 4a) Of the above claim(s) 3,4 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-17,19 and 40-91 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/21/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

1. Applicants' amendments filed on 6/6/2005 have been entered.

### *Election/Restrictions*

2. Applicant's election with traverse of polymethylmethacrylate as the elected species of the flat non-porous unitary matrix, the textile as the elected species of the visible layer and the sink as the elected species of the solid surface in the reply filed on 4/11/2005 is acknowledged.

Upon reconsideration, the Examiner will withdraw the election of species requirement for the visible layer and the solid surface. However, the election of species requirement for the flat non-porous unitary matrix is maintained.

Applicant's traversals with respect to the election of species requirement for the visible layer and the solid surface are moot.

Applicant's traversal with respect to the election of species requirement for the flat non-porous unitary matrix is based on the ground(s) that the generic group of the thermoplastic non-copolyester polymeric material recited in claim 1 sufficiently states a relationship that defeats the criteria for restriction. This is not found persuasive because of the following reason:

First, applicant has amended claims, which contain the new limitations that are not supported by or sufficiently described in the specification as discussed in the following Office action.

Second, even though the amended independent claims contain the generic group, the application still contains claims directed to the patentably distinct species of the generic group.

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In this cases the species are polymethylmethacrylate, polyvinyl chloride, polycarbonate, and combinations thereof. These species are patentably distinct species. As stated in the prior Office action, should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. Applicant has not yet provided such evidence as required.

Since these species are patentably distinct, an additional search for each species is required and a serious burden does exit.

With respect to applicant's concerns about the issuance of two patents for the same invention, if the elected species is not found during the search, the Examiner will extend the search to the next species. Therefore, an issuance of the patent will not be granted until all the species including the generic group are found to be allowable.

The requirement is still deemed proper and is therefore made FINAL.

3. Claims 1-2, 5-17, 19 and 40-91 read on the elected species of the non-porous unitary matrix being the polymethylmethacrylate. Claims 3-4 and 18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 4/11/2005.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2, 5-17 and 40-91 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claims 1-2, 5-17 and 40-91, Applicant has amended claims limitations:

- from "a flat non-porous unitary solid surface" to --non-porous unitary solid surface--,
- from "a flat non-porous unitary matrix made of a polymeric material selected from the group consisting of polymethylmethacrylate, polyvinyl chloride, polycarbonate and combinations thereof" to -- a thermoplastic non-copolyester polymeric material--
- from "visible decorative object" to --decorative object--.

Applicant's amendments have broadened the scope of the claims, which are not supported by or sufficiently described in the specification and are considered to be new matters.

Claims 10-12, 13-15, 47-48, 53, 55, 65, 67, 76, 78, 85 and 87 contain additional limitations which are not supported by or sufficiently described in the specification and are considered to be new matters:

In claims 10-12, applicant has amended claim limitations from a flat non-porous unitary solid surface structure comprising a flat non-porous unitary matrix and a visible decorative object to a five-layer structure. The specification does not support or sufficiently describe the visible decorative objects being sandwiched between the thermoplastic materials in five-layer

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structure. The specification only discloses a three-layer structure and specifies that the structure does not have a layer of decorative material (see FIG. 4 and the description in Example 3).

In claims 13-15, the term “an envelope encompassing the visible object” is not supported by or sufficiently described in the specification.

In claims 47-48, 53, 55, 65, 67, 76, 78, 85 and 87, the limitations of the sink being “bowl-shaped” and the lavatory including a “bowl-shaped basin” are not supported by or sufficiently described in the specification.

If any of these limitations are explicitly supported by the original disclosure, applicants should indicate the page and line numbers where support is found. If support is considered to be implicit, applicants should clearly explain how these limitations are derived from the original disclosure. Any unsupported limitations are required to be deleted from the claims.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2, 5-17 and 40-91 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1-2, 5-17 and 40-91, it is unclear if the non-porous unitary solid surface having the decorative object extends to at least one edge of the matrix is referred to the intermediate product or the finished product.

The following action is based on that the non-porous unitary solid surface is the finished product that the extension of the decorative object at the edge of the matrix was trimmed (in light

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of the disclosure on page 16 of the specification) at the end of the process. The claims are considered to be product-by-process claims.

***Claim Rejections - 35 USC § 102***

6. Claims 1-2, 5-9, 13-17, 19, 49-50 and 72-73 are rejected under 35 U.S.C. 102(b) as being anticipated by Theil et al. (US 5,837,091).

With respect to claims 1-2, 5, 7-8, 16-17, 19 and 49-50, Theil discloses a flat laminated polymethacrylate plastic comprising a flat or oblong object such as pictures, film filaments, fabric strips, wires or steel spirals embedded into the laminates for decorative display such as advertising display (col. 5, lines 55-67).

With respect to claims 6 and 9, Theil discloses the polymethacrylate plastic parts are sheets which have engravings or embossings (col. 2, lines 55-60)

With respect to claims 13-15 and 72-73, the laminate is considered to have an envelope shaped. The laminate comprises polymethylmethacrylate plastic sheets with a flat or oblong object such as pictures, film filaments, wires or steel spirals embedded into the laminates for decorative display (col. 5, lines 55-67). Theil also discloses the polymethacrylate plastic parts are sheets which have engravings or embossings (col. 2, lines 55-60)

It is noted that claims 1-2, 5-9, 13-17, 19, 49-50 and 72-73 are product-by-process claims. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps (MPEP 2113). “[E]ven though product – by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product

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in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 227 USPQ 964, 966. Since the extension of the decorative object at the edge of the matrix was trimmed (in light of the disclosure on page 16 of the specification) at the end of the process. The finished solid surface structure does not have the decorative object extends to the edge of the matrix. Theil anticipates the claimed limitations.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-12 and 60-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Theil as applied to claims 1-2, 5-9, 13-17, 19, 49-50 and 72-73 above, and further in view of the same reference.

As stated above, Theil discloses the same non-porous unitary solid surface structure as recited in claims 1-2, 5-9, 13-17, 19, 49-50 and 72-73.

Theil does not disclose that the laminate comprising the additional sheet of second thermoplastic material and additional visible decorative object layer as recited in claim 10.

However, the additional layers recited are simply the duplicates of the laminate structure disclosed by Theil.

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It has been held that mere duplication of the essential working parts of a structure involves only routine skill in the art. *St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8. The court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced, *see* MPEP 2144.04 VI B.

Therefore, absent of showing unexpected results, it would have been obvious to one of ordinary skill to make multilayer of laminate structure by simply duplicating the same structure disclosed by Theil in order to provide more visible effects.

8. Claims 1-2, 5-9, 13-17, 40-61 and 63-91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eckart et al (5,894,048) in view of Kaetsu et al. (US 4,138,300).

With respect to claims 1-2, 5-17, 19, 13-15 and 72-73, Eckart discloses a decorative laminate comprising a decorative image such as printed or colored film layer permanently fixated between the thermoplastic polymeric material layers. The laminate is also considered to have an envelope shaped.

Eckart also discloses the surface of the polymeric material is embossed or textured.

With respect to claims 40-48, 51-59, 63-71 and 74-91, Eckart discloses the solid surface comprising the laminate is used as a building material such as counter tops, table tops, hot tubs sink, soap dish (col. 8, lines 55-65).

It is noted that claims 1-2, 5-9, 13-17, 40-61 and 63-91 are product-by-process claims. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps (MPEP 2113). “[E]ven though product – by process claims are limited by and defined by the process, determination of patentability is based on the product

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itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 227 USPQ 964, 966. Since the extension of the decorative object at the edge of the matrix was trimmed (in light of the disclosure on page 16 of the specification) at the end of the process. The finished solid surface structure does not have the decorative object extends to the edge of the matrix.

Eckart does not disclose the thermoplastic is polymethylmethacrylate.

With respect to claims 1-2, 10, 13, 16-17, 49-50, 60-62, and 72-73, Kaetsu teaches the use of polymethylmethacrylate in a wide variety of applications such as interior decoration, displays, building materials because it is less expensive and has improved transparency, appearance, impact resistance, and weather resistance (col. 1, lines 10-30).

Therefore, it would have been obvious to one of ordinary skill in the art to use polymethylmethacrylate as the thermoplastic material in Eckart’s decorative laminate because it’s less expensive and has improved transparency, appearance, impact resistance, and weather resistance, as taught by Kaetsu.

9. Claims 10-12 and 60-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eckart et al and Kaetsu et al., as applied to claims 1-2, 5-9, 13-17, 40-61 and 63-91 above, and further in view of the same reference.

As stated above, Eckart and Kaetsu disclose the same non-porous unitary solid surface structure as recited in claims 1-2, 5-9, 13-17, 40-61 and 63-91.

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Eckart and Kaetsu do not disclose that the laminate comprising the additional sheet of second thermoplastic material and additional visible decorative object layer as recited in claim 10.

However, the additional layers recited are simply the duplicates of the laminate structure disclosed by Theil.

It has been held that mere duplication of the essential working parts of a structure involves only routine skill in the art. *St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8. The court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced, *see* MPEP 2144.04 VI B.

Therefore, absent of showing unexpected results, it would have been obvious to one of ordinary skill to make multilayer of laminate structure by simply duplicating the same structure disclosed by Eckart and Kaetsu in order to provide more visible effects.

10. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eckart et al and Kaetsu et al., as applied to claims 1-2, 5-9, 13-17, 40-61 and 63-91 above, and further in view of Theil et al (US 5,837,091).

As stated above, Eckart and Kaetsu disclose the same non-porous unitary solid surface structure as recited in claims 1-2, 5-9, 13-17, 40-61 and 63-91.

Eckart and Kaetsu do not disclose that the decorative material is a textile.

However, using textile as the decorative material is well known in the art and not the invention of the present application. For example, Theil teaches the use of fabric strips as the decorative material. Therefore, it would have been obvious to one of ordinary skill in the art to

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use textiles material as the decorative material for the specific visible effects provided by the textile materials.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ling X. Xu whose telephone number is 571-272-1546. The examiner can normally be reached on 8:00 - 4:30 Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah D. Jones can be reached on 571-272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ling X. Xu  
Examiner  
Art Unit 1775